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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,648	12/20/2000	Makoto Hagai	2000_1730A	4265

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WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,648

Applicant(s)

HAGAI ET AL.

Examiner

Prieto Beatriz

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 9-12 is/are allowed.
- 6) ☒ Claim(s) 8 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/20/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date included
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Amendment filed 04/07/05; claims 1-12 remain pending and in accordance to telephonic interview dated 05/16/05. Claims 1-13 remain pending.
2. Finality of previous office action is hereby withdrawn and statutory response time restarted due to minor informality noted. Namely, newly added claim 13 was inadvertently not considered in previous office action.
3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
4. Claims 1-7, and 9-12 are allowed.
5. Claim 13 recites a negative limitation (i.e. "without transmitting an instruction specified by an "upper communication protocol"). Negative limitation(s) require that the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Limitations should not define the invention in terms of *what it was not*, or *excluding what the inventors did not invent rather than distinctly and particularly point out the invention*. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). Any negative limitation or exclusionary proviso *must have basis in the original disclosure*. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims (see MPEP 2173.05(i). See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant is urged to point supportive disclosure. Including those describing the interruption of data reception *without sending an instruction that is specified by an "upper" layer to the transmitting end, without newly adding a transmission stop/pause or restart instruction to a "lower" protocol*.

For the purposes of examination claimed terms “lower” and “upper” communication protocols are communication protocols given the broadest reasonable interpretation in light of the specification (see MPEP 2111 or 2106)

In this case, applicant is urged to point out in the invention’s disclosure where is the above-mentioned limitation described.

Claim Rejection under C.F.R. 103

6. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

7. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over BLAHUT et. al. (US 5,442,389 (referred to as Blahut hereafter) in view of White et. al. (US 6,628,302) (referred to as White hereafter).

Regarding claim 8, Blahut teaches receiving and playing audio or video data streams (abstract) via a distribution network

requesting for transmission to be stop/pause (“halted”) to server “transmitting end” (Fig. 9), and halting temporarily data reception (col 14/lines 28-45, col 24/lines 31-42); and requesting for transmission to be restarted (“play”) to the transmitting end, and restarting data reception (col 14/lines 28-45), however does not teach where data reception is from a “lower” communication protocol;

White teaches the transmission of interactive services providing data reception via a “lower” communication protocol (col 2/lines 12-17, 42-46), interactive services include an user interface provided to the user enabling the user to pause transmission of video services, transmitting a pause instruction to the transmitting end, i.e. head end interrupting data reception and resumed from that point on shortly afterwards (col 4/line 39-col 5/line 26).

It would have been obvious to one ordinary skilled in the art given the teachings of Blahut for receiving and playing audio/video data streams via a distribution network, e.g. head-end distribution system via telephone networks or microwave distribution systems as suggested by Blahut, the teachings of White for the distribution of multimedia by head-end distribution systems would be readily apparent. One would be motivated enhance existing head-end based distribution systems with interactive web based services supported by proxy server providing to the users system control and user interface function via a logical lower communication (e.g. TCP/IP) control channel between the head-end and clients, allowing user to switch between video entertainment to interactive entertainment seamlessly.

Regarding claim 13, wherein the request for transmission halt to the transmitting end is made without transmitting an instruction specified by "upper" communication protocol to the transmitted end (White: column 4/lines 65-column 5/line 5).

Response to Arguments

8. Regarding claim 8 rejected under 103 35 U.S.C. 103(a) as being unpatentable over BLAHUT in view of White, it is argued, that the White reference does not teach claim limitation as recited. Specifically, "halting data reception from lower communication protocol" and "restarting data reception from the lower communication protocol". Because according to applicant's interpretation the stop or pause instruction is provided at an "upper" layer relative to a "lower" layer communication protocol.

In response to the above-mentioned argument, claim has been given the broadest reasonable interpretation in light of the specification (see MPEP 2111). It is not clear in the White reference, what Applicant equates to an "upper" layer protocol based on the invention's specification. For the purposes of claim interpretation, Applicant is urged to set forth the meaning of the claim language (relative terms, "upper" and/or "lower" see MPEP 2173.06) wherever he/she finds it necessary. In this case, argued claim limitations read that both the halting and restarting from the lower communication protocol are made by a respective request made to the transmission end.

White teaches where interactive services and control **data are transmitted using conventional protocol** (e.g. TCP/IP) and modulated onto a suitable carrier frequency for distribution over the network, or such **data can be transmitted** in the vertical blanking interval of analog video broadcasts, as is well known (see col 2/lines 33-48) i.e. "data reception" is provided from a "lower communication protocol".

White further discloses where a video control panel (HTML based) UI 74 is transmitted and presented on the subscriber's screen (Fig. 5). The panel 74 PLAY, STOP, REWIND, FAST FORWARD, and PAUSE buttons 76A-E (col 4/lines 39-49); If, during playback, the user wishes to **stop or pause delivery of the on-demand video temporarily**, a "Menu" button on the remote control is pressed. The video control panel 74 reappears, this time with the STOP button highlighted. If the user wishes to stop playback, the "Go" button on the remote is pressed. If the user wishes to pause playback, the highlighting on the control panel is moved to the PAUSE button using arrow keys on the remote control, and the "Go" button is then pressed. A corresponding **stop or pause instruction is then sent to the head-end 12 from the client terminal 14, interrupting MPEG delivery**, i.e. "data reception" (col 4/line 60-col 5/line 9); When either the STOP or PAUSE button is activated on the panel 74, the panel

74 persists on the screen, but the highlighting is switched back to PLAY. (If the PAUSE button is used to resume playback following a pause instruction, and the user activates the PAUSE button to interrupt the video, the highlighting can remain at the PAUSE button.) This arrangement permits the viewer to resume playback simply by pressing "Go" on the remote, since the button that resumes playback is already highlighted. (The panel similarly persists on-screen if the REWIND or FAST FORWARD buttons is activated, with PLAY next highlighted.) (col 5/lines 15-26). In this manner, White teaches halting data reception from lower communication protocol" and "restarting data reception from the lower communication protocol".

9. Regarding claim 8 rejected under 103 35 U.S.C. 103(a) as being unpatentable over BLAHUT in view of White, it is argued, that the White reference does not teach claim limitation recited. Specifically, stopping transmission to the transmitting end by interrupting data reception from a "lower" communication protocol without sending an instruction that is specified by an upper layer to the transmitting end and without modifying a "lower" communication protocol, that is, without newly adding a transmission stop/pause or restart instruction to a "lower" protocol, and wherein the pause and stop instruction to the entertainment head-end is provided at an "upper" layer relative to a "lower" communication protocol.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., stopping transmission to the transmitting end by interrupting data reception from a "lower" communication protocol *without sending an instruction that is specified by an upper layer to the transmitting end and without modifying a "lower" communication protocol, that is, without newly adding a transmission stop/pause or restart instruction to a "lower" protocol*, and wherein the pause and stop instruction to the entertainment head-end is provided at an "upper" layer relative to a "lower" communication protocol) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). This is not a suggestion of any sort.

10. Applicant's arguments filed 04/07/05 have been fully considered but not found persuasive.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to the Central Fax Office:
(703) 872-9306, for Official communications and entry;

Or Telephone:
(703) 306-5631 for TC 2100 Customer Service Office.


BEATRIZ PRIETO
PRIMARY EXAMINER